

Application No.: 09/682,329  
Amendment dated: November 22, 2004  
Reply to Office Action of August 26, 2004  
Attorney Docket No.: 21295.39

## b) Remarks

Claims 1-18 are pending in this application. Independent Claims 1, 7 and 13 have been amended in various particulars as indicated hereinabove.

Turning now to the merits, Claims 1-18 were rejected under 35 U.S.C. 102(b) as being anticipated by Jansson, et al., US Patent No. 4,672,559. This rejection is respectfully traversed for the following reasons.

It is well established that a claim is anticipated under 35 U.S.C. §102, only if each and every element of the claim is found in a single prior art reference.<sup>1</sup> Moreover, to anticipate a claim under 35 U.S.C. §102, a single source must contain each and every element of the claim "arranged as in the claim."<sup>2,3</sup> Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference.<sup>4</sup> If each and every element of a claim is not found in a single reference, there can be no anticipation.

With respect to the "automatic focusing" element of claims 6 and 18, the Examiner states that Jansson teaches this at col. 6 lines 34-42. Examination of Jansson reveals what is taught at col. 6, lines 34-42:

"FIGS. 2A through 2K are used to exemplify the system operation. More particularly, each pair of FIGS. 2A, 2B; 2C, 2D; 2E, 2F; 2G, 2H; and 2I, 2J, represent a microscopic field of view and a tracking display for that field of view at the magnifications indicated below each illustrated field of view. FIG. 2K is the display of the data obtained from the following typical mapping sequence of operations as seen on the mapping display monitor 26."

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<sup>1</sup> *Veregal Bros. v Union Oil Co. of California*, 814 F.2d 628, 631, 2USPQ2d 1051, 1053 (Fed. Cir. 1987).

<sup>2</sup> *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984).

<sup>3</sup> *Lewmar Marine Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q. 2d 1766, 1768 (Fed. Cir. 1987), cert. denied, 484 U.S. 1007 (1988).

<sup>4</sup> *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 780, 227 U.S.P.Q. 773, 777 (Fed. Cir. 1985).

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The element of "Automatic focusing," is not even mentioned Anywhere in Jansson. The element of automatic focusing has now been incorporated into every independent claim, including claim 7. Applicant submits that the independent claims, as now amended, are not anticipated by Jansson, and that the claims depending on the independent claims are also not anticipated.

Applicant believes that the present application is in condition for allowance. A Notice of Allowance is respectfully solicited. Should any questions arise, the Examiner is encouraged to contact the undersigned.

Respectfully submitted,

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